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|--|-------------|-----------------------|------------------|
| APPLICATION NUMBER   | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 08/731,499   | 10/16/96    | GRAY                  | J 023070-06891   |
|  |             | EXAMINER              |                  |
| 18M1/1112  |             |                       |                  |
| TOWNSEND AND TOWNSEND AND CREW<br>8TH FLOOR<br>TWO EMBARCADERO CENTER<br>SAN FRANCISCO CA 94111-3834 |             | DAVIS, M<br>ART UNIT  | PAPER NUMBER     |
|  |             | 1806                  | 12               |
|  |             | DATE MAILED: 11/12/97 |                  |

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 10/6/97, paper # 11

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1 - 44 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) 1 - 44 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1806

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### **RESTRICTION**

Applicant traverses the restriction requirement, and did not elect any group. The traversal is on the ground that Groups I-IV should be rejoined, because a search for prior art of group I would identify any prior art pertaining to the uses of nucleic acid sequences of group I. Thus examination of all four groups can be made without serious burden.

After consideration of applicant's arguments, group I is rejoined to group II, because it is not a burden for the examiner to search those two groups together. However, groups III-IV remain, because examination of the method of screening of group III which uses antibodies to the claimed polypeptides, would require separate search for antibodies of said polypeptides. Furthermore, the scope, biochemical assays, reagents and protocols of the method of group II are different from those of group III, because group II uses as probes nucleic acid sequences, whereas group III uses as probes antibodies. Moreover, the scope, objectives, and protocols of the method of group IV, drawn to treating diseases, are different from those of groups II-III, drawn to screening diseases.

In addition, it is further required that applicant chooses any of sequences, SEQ ID Nos 1-12, for any of groups (I-II), III, and IV, because said sequences are structurally distinct, and it is a burden for the examiner to examine all these sequences together.

Art Unit:

Minh-Tam B. Davis

November 8, 1997



**LILA FEISEE  
SUPERVISORY PATENT EXAMINER  
GROUP 1800**



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